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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Joyce Phillips

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05/12/2009

KING & SPALDING LLP (CITI CUSTOMER NUMBER)

ATTN: GEORGE T. MARCOU

1700 PENNSYLVANIA AVENUE, NW

SUITE 200

WASHINGTON, DC 20006

EXAMINER

NGUYEN, NGA B

ART UNIT

PAPER NUMBER

3692

MAIL DATE

DELIVERY MODE

05/12/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/078,669	Applicant(s) PHILLIPS, JOYCE	
	Examiner Nga B. Nguyen	Art Unit 3692	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 February 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 37-50 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 37-50 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This Office Action is the answer to the communication filed on February 20, 2009, which paper has been placed of record in the file.
2. Claims 37-50 are elected for consideration in this application.

Response to Arguments/Amendment

3. Applicant's arguments with respect to claims 37-50 have been fully considered but are not persuasive.

In response to applicant's arguments regarding to claims 37-50 that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

Examiner would like to point out that the Supreme Court in *KSR* described seven rationales to support rejections under 35 U.S.C. 103:

- Combining prior art elements according to known methods to yield predictable results;
- Simple substitution of one known element for another to obtain predictable results;
- Use of known technique to improve similar devices (methods, or products) in the same way;

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- Applying a known technique to a known device (method, or product) ready for improvement to yield predictable results;
- “Obvious to try” –choosing from a finite number of identified, predictable solutions, with a reasonable expectation of success;
- Known work in one field of endeavor may prompt variations of it for use in either the same field or a different one based on design incentives or other market forces if the variations would have been predictable to one of ordinary skill in the art; and
- Some teaching, suggestion, or motivation in the prior art that would have led one of ordinary skill to modify the prior art reference or to combine prior art reference teachings to arrive at the claimed invention.

In this case, the combined of Ausems, Dethloff and Pitroda would obtain predictable result as indicated in the rejection.

For the reason set forth above, examiner decides to maintain the previous rejection (also see details below) and make this Office action FINAL.

4. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 37-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ausems et al (hereinafter Ausems), U.S. Patent No. 6,434,403, in view of Dethloff, U.S. Patent No. 6,047,888, and further in view of Pitroda, U.S. Patent No. 7,308,426.

Regarding to claim 37, Ausems discloses a system for electronic commerce comprising:

a wireless communication device (*figures 1a-1d and column 3, lines 5-20, the PDA wireless phone 100*);

a transaction card reader connected to said communication device (*column 4, lines 40-50, smartcard slot 155*);

a transaction card (*column 4, lines 40-55, smartcard 160*);

a first antenna for communication with the wireless communication device (*column 3, lines 35-50, antenna 110*);

a display connected to the wireless communication device for conducting a transaction using the transaction card (*column 6, lines 8-45, **display 145**, a user may purchase items using PDA telephone 100 and a cash card/debit card/credit card and other smartcard*)

wherein the transaction card exchanges second data with the wireless communication device (*column 4, lines 40-50, smartcard reader/writer reads and writes information stored on a smartcard*);

Ausems does not disclose a second antenna embedded within a body of the transaction card for communication with a receiving terminal, wherein the second antenna communicates from the transaction card connected to the communication device to a merchant card reader to perform the transaction. However, Dethloff discloses a second antenna embedded within a body of the transaction card for communication with a receiving terminal (*figure 8 and column 16, lines 5-50, a data medium or card 20 includes **an antenna 46 for contactless communication** with the vendor terminal*). Pitroda discloses the transaction card connected to the communication device to a merchant card reader to perform the transaction (*column 8, lines 5-35, POS terminals include card readers; conducting transaction using electronic transaction device 12 at the POS terminal 20*). Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to modify Ausems's to incorporate the feature taught by Dethloff's and Pitroda's above, for the purpose of providing a convenient way (contactless) for the transaction card to communicate with the receiving terminal.

Ausems does not disclose the display for presenting payment options. However, Pitroda discloses the display for presenting payment options (*column 7, lines 18-40, the electronic transaction device 12 is used to conduct a transaction, a client may wish to pay for a restaurant bill with a credit card account on an electronic transaction device 12, the client then may select a credit card account on the client's electronic transaction device 12*). Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to modify Ausems's to incorporate the feature taught by Pitroda's above, for the purpose of providing a convenient way for the user to pay for the transaction by presenting payment options.

Ausems does not disclose wherein the transaction card and the wireless communication device are provided together to a customer by a mobile telephone service provider during an application event. However, Pitroda discloses wherein the transaction card and the wireless communication device are provided together to a customer by a transaction service provider during an application event (*figure 10, column 11, line 25-column 12, line 15; column 17, lines 45-65, an electronic transaction device 12 and a Master card issued by Citibank are provided together to the client by the transaction service provider 10; the client can apply for a new credit card from a financial institution through the transaction service provider 10*). Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to modify Ausems's to adopt the teaching of Pitroda's above, for the purpose of providing to the customer various services associated with the wireless communication

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device in order to encourage the customer to purchase the wireless communication device.

Ausems does not disclose wherein the transaction card stores first data on bundled financial products under a single brand name that are accessed through a first proprietary network; wherein the transaction card comprises third data of at least one payment brand for use in an open network; and wherein the transaction card is associated with a loyalty program for usage of the wireless communication device.

However, Pitroda discloses wherein the transaction card stores first data on bundled financial products under a single brand name that are accessed through a first proprietary network (*column 5, lines 50-55, the electronic transaction device is used to conduct transactions involving promotional information, e.g., usage intensive such as frequent flier miles, cash back rebates, or any various intensive programs offered by credit card issuers; in this case, the credit card includes bundled financial products because it contains credit line and intensive program*); wherein the transaction card comprises third data of at least one payment brand for use in an open network (*column 13, lines 3-10, payment brand: Master Card, Visa, American Express, Discover, Diner Clubs, etc.*); wherein the transaction card is associated with a loyalty program for usage of the wireless communication device (*column 5, lines 50-55, the electronic transaction device is used to conduct transactions involving promotional information, e.g., usage intensive such as frequent flier miles, cash back rebates, or any various intensive programs offered by credit card issuers*). Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to modify Ausems's to

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incorporate the teaching of Pitroda's above, for the purpose of providing to the customer the transaction card includes bundle financial products in order to encourage the customer to use the transaction card to purchase goods or services.

Regarding to claim 38, Ausems further discloses wherein the communication device provides Internet Access (*column 6, lines 1-2, PDA wireless phone 100 has Internet access*).

Regarding to claim 39, Ausems further discloses wherein the transaction card is a smart card (*column 4, lines 40-55, smartcard 160*).

Regarding to claim 40, Ausems further discloses wherein the communication device is a mobile phone (*figures 1a-1d and column 3, lines 5-20, the PDA wireless phone 100*).

Regarding to claim 41, Ausems further discloses an Internet browser displayed on a display the communication device (*column 8, lines 1-5, the PDA wireless phone includes web browser for Internet access*).

Regarding to claim 42, Ausems does not disclose wherein the receiving terminal is a vending machine. However, Dethloff discloses wherein the receiving terminal is a vending machine (*column 13, lines 24-40, the data medium 20 communicates with a vending machine for purchasing goods*). Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to modify Ausems's to incorporate the feature taught by Dethloff's the above, for the purpose of providing more

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convenient for the user to purchase goods at the vending machine using a transaction card.

Regarding to claim 43, Ausems further discloses wherein the receiving terminal is a point-of-sale terminal (*column 6, lines 20-30, the PDA wireless phone 100 can communicate with various point-of-sale terminals*).

7. Claim 44 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ausems et al (hereinafter Ausems), U.S. Patent No. 6,434,404, in view of Dethloff, U.S. Patent No. 6,047,888, in view of Pitroda, U.S. Patent No. 7,308,426, and further in view of Natsuno, U.S. Patent No. 6,910,624.

Regarding to claim 44, Ausems does not disclose wherein the receiving terminal communicates with a payment center gateway to determine whether an account of the customer is sufficient to support a transaction associated with the receiving terminal. However, Natsuno discloses wherein said receiving terminal communicates with a payment center gateway to determine whether an account of said consumer is sufficient to carry out a transaction associated with said receiving terminal (*column 15, lines 40-55, merchant server transmits the credit card contract information and sales amount information to the credit company's server, the credit company server retrieves the credit information in the member database and determines if the credit limit is not exceeded*). Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to modify Ausems's to incorporate the feature taught by Natsuno's above, for the purpose of verifying credit card information in order to decide to approve or reject the transaction.

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8. Claims 45, 47 and 49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ausems et al (hereinafter Ausems), U.S. Patent No. 6,434,403, in view of Pitroda, U.S. Patent No. 5,590,038.

Regarding to claim 45, Ausems discloses a system for electronic commerce comprising:

a mobile telephone (*figures 1a-1d and column 3, lines 5-20, the **PDA wireless phone 100***) comprising:

a receptacle for a smart card (*column 4, lines 40-50, **smartcard slot 155***),

a display accessing an Internet browser and for presenting a purchase option in a transaction accessing data from the first storage or the second storage (*column 6, lines 8-45, **display 145**, a user may purchase items using PDA telephone 100 and a cash card/debit card/credit card and other smartcard; column 6, lines 1-2, PDA wireless phone 100 has Internet access*); and

a keypad for selecting options on the display to conduct a transaction using data from the first storage or the second storage (*column 3, line 65-column 4, line 10, **Buttons 130**; column 6, lines 8-18, **touchscreen display 145***).

Ausems does not disclose but Pitroda discloses:

the smart card comprising (see figure 4 and column 11, lines 40-60):

a first data storage for storing data for at least two financial products selected from the group consisting of a credit line, cash advance line, stored value, debit capability, and bill payment (*figure 4, bank cards 405*);

a second data storage for storing data for a credit card account (*figure 4, credit cards 404*); and

a third data storage for storing information comprising customer name and customer number (*figure 4, personal data 403*).

a first payment brand for utilizing at least one of the financial products having data stored in the first data storage, wherein the first payment brand is configured to be used within a proprietary network (*column 14, lines 40-50, ATM card and ATM transactions*);

a second payment brand for utilizing the credit card account having data stored in the second data storage, wherein the second payment brand is configured to be used in a non-proprietary network (*column 16, lines 20-50, credit card and credit card transactions*);

Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to modify Ausems's to incorporate the teaching of Pitroda's above, for the purpose of providing to the customer the smart card includes bundle financial products in order to encourage the customer to use the smart card to purchase goods or services.

Ausems does not disclose wherein the smart card is provided by a mobile telephone service provider. However, Pitroda disclose wherein the smart card is provided by a mobile telephone service provider (*figure 10, column 11, line 25-column 12, line 15; column 17, lines 45-65, an electronic transaction device 12 and a Master card issued by Citibank are provided together to the client by the transaction service provider 10; the client can apply for a new credit card from a financial institution through the transaction service provider 10*). Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to modify Ausems's to adopt the teaching of Pitroda's above, for the purpose of providing to the customer various services associated with the wireless communication device in order to encourage the customer to purchase the wireless communication device.

Regarding to claim 47, Ausems further discloses wherein the mobile telephone communicates with a merchant gateway to allow a user to access a merchant to conduct a transaction (*column 6, lines 30-45, a user may purchase items using PDA telephone 100 to communicate with merchant terminal to conduct transaction*).

Regarding to claim 49, Ausems combined Pitroda further discloses wherein the mobile telephone retrieves data in a first storage, second storage, or a third storage and provides the data to the merchant gateway (*column 6, lines 35-45, the smart-card engine 260 reads the card account information and transmits it to the point of sale terminal*).

9. Claim 46 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ausems et al (hereinafter Ausems), U.S. Patent No. 6,434,403, in view of Pitroda, U.S. Patent

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No. 5,590,038, and further in view of Pitroda, U.S. Patent No. U.S. Patent No. 7,308,426.

Regarding to claim 46, Ausems does not disclose a point storage for accumulating points related to usage of the financial products. However, Pitroda (US 7,308,426) discloses a point storage for accumulating points related to usage of the financial products. (*column 5, lines 50-55, the electronic transaction device is used to conduct transactions involving promotional information, e.g., usage intensive such as frequent flier miles, cash back rebates, or any various intensive programs offered by credit card issuers*). Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to modify Ausems's to incorporate the teaching of Pitroda's above, for the purpose of providing to the customer the smart card includes a point storage for accumulating points in order to encourage the customer to use the smart card to purchase goods or services.

10. Claim 48 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ausems et al (hereinafter Ausems), U.S. Patent No. 6,434,404, in view of Pitroda, U.S. Patent No. 5,590,038, and further in view of Natsuno, U.S. Patent No. 6,910,624.

Regarding to claim 48, Ausems does not disclose wherein the merchant gateway accesses a payment center gateway to access a storage comprising account information related to at least one financial product. However, Natsuno discloses wherein the merchant gateway accesses a payment center gateway to access a storage comprising account information related to at least one financial product (*column 15, lines 40-55, merchant server transmits the credit card contract information and sales*

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amount information to the credit company's server, the credit company server retrieves the credit information in the member database and determines if the credit limit is not exceeded). Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to modify Ausems's to incorporate the feature taught by Natsuno's above, for the purpose of verifying credit card information in order to decide to approve or reject the transaction.

11. Claim 50 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ausems et al (hereinafter Ausems), U.S. Patent No. 6,434,404, in view of Pitroda, U.S. Patent No. 5,590,038, and further in view of Dethloff, U.S. Patent No. 6,047,888 and Pitroda, U.S. Patent No. U.S. Patent No. 7,308,426.

Regarding to claim 50, Ausems does not disclose wherein the smart card further comprises an antenna for communicating with a card reader without requiring contact with the smart card. However, Dethloff discloses wherein the smart card further comprises an antenna for communicating with merchant without requiring contact with the smart card (*figure 8 and column 16, lines 5-50, a data medium or card 20 includes an antenna 46 for contactless communication with the vendor terminal*). Pitroda (US 7,308,426) discloses the merchant having a card reader (*column 8, lines 5-35, POS terminals include card readers; conducting transaction using electronic transaction device 12 at the POS terminal 20*). Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to modify Ausems's to incorporate the feature taught by Dethloff's and Pitroda's above, for the purpose of

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providing a convenient way (contactless) for the transaction card to communicate with the merchant terminal.

Conclusion

12. Claims **37-50** are rejected.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner Nga B. Nguyen whose telephone number is (571) 272-6796. The examiner can normally be reached on Monday-Thursday from 9:00AM-6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kambiz Abdi can be reached on (571) 272-6702.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (571) 272-3600.

14. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

P.O. Box 1450

Alexandria, VA 22313-1450

Or faxed to:

(703) 273-8300 (for formal communication intended for entry),

or

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(571) 273-6796 (for informal or draft communication, please label "PROPOSED" or "DRAFT").

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Nga B. Nguyen/
Primary Examiner, Art Unit 3692

May 5, 2009